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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,859	08/23/2001	Masahiko Enari	09812.0651	9497
22852 7590 01/26/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER REFAI, RAMSEY	
			ART UNIT 2152	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/935,859

Applicant(s)

ENARI, MASAHICO

Examiner

Ramsey Refai

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Responsive to Amendment received November 20, 2006. Claims 1-5 have been amended and remain pending examination.

Response to Arguments

1. Applicant's arguments have been fully considered but they are not persuasive.
 - In the remarks, the Applicant argues in substance that Rautila fails to teach an identification code for individually identifying electronic content retrieved from among the available electronic contents.
 - In response, the Examiner respectfully disagrees. After the user selects a particular digital product desired from among the titles available on the electronic shop server (column 6, lines 1-8), the user receives a unique order number, which corresponds to the selected digital product as well as other information (column 9, lines 60-63, column 6, lines 1-8 and 35-38). The unique order number is used to obtain the desired digital product from the electronic shop server, which meets the limitation of "an identification code for individually identifying electronic content retrieved from among the available electronic contents". Therefore Rautila meets the scope of the claimed limitation.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to now recite “ *an identification code for individually identifying electronic content retrieved from among the available electronic contents.*” No support for this new amendment can be found in the applicant’s disclosure. The specification furthermore does not define the term individually.

Claim Rejections – 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila (U.S. Patent No. 6,714,797) in view of Gould et al (U.S. Patent No. 4,300,040)

5. As per claim 1, Rautila teaches an electronic content providing method for performing electronic content provision to a user by using a remote user terminal and an information terminal in a store, said electronic content providing method comprising the steps of:

accessing a menu of available electronic contents using said remote user terminal
(column 6, lines 2-7);

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acquiring an identification code for individually identifying electronic content retrieved from among the available electronic contents by using said user terminal linked via a network to a server in which the available electronic contents are recorded (column 6, lines 35-40, column 8, lines 31-37);

inputting the identification code to said information terminal (column 6, lines 34-53); and supporting the downloading of the retrieved electronic content to a recording medium in response to the step of inputting the identification code to said information terminal (column 6, lines 5-60, column 8, lines 25-45).

6. Although Rautila teaches that a user can browse content available at the electronic shop server prior to selecting content to purchase (column 6, lines 1-9) and also teaches that a confirmation request is sent to the user to confirm the selected content (column 6, lines 53-57), Rautila fails to explicitly teach supporting a preview of the retrieved electronic content identified by the identification code after inputting the identification code. However, the feature of previewing the content selected prior to purchase is well known in the art as evidenced by Gould et al. Gould et al teach a terminal in which a customer can preview content selected for purchase. After inputting the identification code representing the selected content, the user can view a preview of the selected content prior to purchasing the selected content. (column 2, lines 30-47). It would have been obvious to one of the ordinary skill in the art at the time of the Applicant's invention to combine Rautila and Gould et al because doing so would allow a user to preview the selected content as part of an order confirmation process, in order to ensure that the content displayed as selected for purchase is indeed the content desired for purchase by the user.

7. As per claims 2-5, these claims contain similar limitations as claim 1 above, therefore are rejected under the same rationale.

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8. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila (U.S. Patent No. 6,714,797) in view of Bernard et al (U.S. Patent No. 5,918,213)

9. As per claim 1, Rautila teaches an electronic content providing method for performing electronic content provision to a user by using a remote user terminal and an information terminal in a store, said electronic content providing method comprising the steps of:

accessing a menu of available electronic contents using said remote user terminal (column 6, lines 2-7);

acquiring an identification code for individually identifying electronic content retrieved from among the available electronic contents by using said user terminal linked via a network to a server in which the available electronic contents are recorded (column 6, lines 35-40, column 8, lines 31-37);

inputting the identification code to said information terminal (column 6, lines 34-53); and supporting the downloading of the retrieved electronic content to a recording medium in response to the step of inputting the identification code to said information terminal (column 6, lines 5-60, column 8, lines 25-45).

10. Although Rautila teaches that a user can browse content available at the electronic shop server prior to selecting content to purchase (column 6, lines 1-9) and also teaches that a confirmation request is sent to the user to confirm the selected content (column 6, lines 53-57), Rautila fails to explicitly teach supporting a preview of the retrieved electronic content identified by the identification code after inputting the identification code. However, the feature of previewing the content selected prior to purchase is well known in the art as evidenced by Bernard et al. Bernard et al teach product samples, such as movie previews, sample cuts from music tracks, software demo, and the like, are provided to the customer so the customer can

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evaluate the product prior to purchasing (abstract, column 3, lines 8-41). It would have been obvious to one of the ordinary skill in the art at the time of the Applicant's invention to combine Rautila and Bernard et al because doing so would allow a user to preview the selected content in order to ensure that the content selected for purchase is indeed the content desired for purchase by the user.

11. As per claims 2-5, these claims contain similar limitations as claim 1 above, therefore are rejected under the same rationale.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai
Examiner
Art Unit 2152
January 19, 2007



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER